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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,842	07/20/2000	Friedrich Roell	ZIP 1782D1	2962

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SMITH-HILL AND BEDELL, P.C.  
16100 NW CORNELL ROAD, SUITE 220  
PORTLAND, OR 97006

EXAMINER

WORRELL JR, LARRY D

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/619,842

Applicant(s)

ROELL, FRIEDRICH

Examiner

Danny Worrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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## DETAILED ACTION

### *Claim Objections*

Claims 29-32 are objected to because of the following informalities: The letters designating individual method steps should be placed within parenthesis. Also the terms “deactivated” and “reactivated” in claim 31 should be “deactivating” and “activating”.

Appropriate correction is required.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6122937. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to provide a knit product as set forth in claims 17-28 via the process in claims 1-5 of U.S. Patent No. 6122937.

Claims 29-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-10 of U.S. Patent No. 6122937. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to provide a knit product as set forth in claims 29-32 via the process in claims 6-9 of U.S. Patent No. 6122937.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-20 and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by British patent document 469998.

British patent document 469998 teaches the shaped knit as claimed including a plurality of discrete deformation regions (regions of change from a single loop to double loop as seen in figures 1 at for example wale 2, course 17) distributed over the knit whereby the density of deformation regions in an area of the knit determines the degree of shaping of the knit in that area. Inherently the number of deformations in a given area sets forth the amount of fashioning or shaping. Regarding claim 18, note that the deformation regions have a width of less than 10 loops. The deformation region is a widening via spilt loop as set forth by British patent document 469998 at page 1, lines 17-27 and page 4, lines 12-92. Regarding claims 22-25, in assessing the subject matter of product-by-process claims, it is necessary to bear in mind

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certain principles. Foremost among these is the principle that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969). Thus, the patentability of a product does not depend on the method of production. Thorpe, supra. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Thorpe, supra; In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983). The Court of Customs and Patent Appeals discussed these principles as well as the rationale for rejection of such claims over prior art disclosures of products in In re Brown, 459 F.2d 531, 173 USPQ 685 (CCPA 1972) as follows:

In order to be patentable, a product must be novel, useful and unobvious. In our law, this is true whether the product is claimed by describing it, or by listing the process steps used to obtain it. This latter type of claim, usually called a product-by-process claim, does not inherently conflict with the second paragraph of 35 USC 112. That method of claiming is therefore a perfectly acceptable one so long as the claims particularly point out and distinctly claim the product or genus of products for which protection is sought and satisfy the other requirements of the statute. It must be admitted, however, that the lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.

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Thus, although process limitations distinguishing the product over the prior art must be given the same consideration as traditional product characteristics, In re Hallman, 655 F.2d 212, 210 USPQ 609 (CCPA 1981), In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973), and although product-by-process claims are limited by and defined by the process, determination of patentability remains based upon the product itself, Thorpe, 227 USPQ at 966.

In view of the similarities between the claimed method steps, e.g. knitting loops and knitting widening or narrowing loops at a plurality of discrete deformation regions distributed over the knit, it is reasonable to believe that the product made by the prior art process would be either identical to the claimed product. In such a situation, the burden of proof shifts to applicant to prove that the claimed product is materially different.

### ***Response to Arguments***

Applicant's arguments filed 6/4/01 have been fully considered but they are not persuasive. In response to applicant's argument that regions of the instant invention are not extended deformation boundaries or lines and thus the degree of shaping of any area of the knit is not controlled by the size and extent of the deformation boundaries or lines as in GB '998, it should be noted that these specific negative limitations are not set forth in claim 17. Even if they were recited they would be considered new matter. The only claimed feature is "a plurality of discrete deformation regions distributed over the knit whereby the density of deformation regions in an area of the knit determines the degree of shaping of the knit in that area". This is clearly the case as shown in the reference of GB'998 as set forth above in the rejection. The fabric of GB '998 gradually becomes wider as more deformations are introduced into the fabric.

Concerning the argument that widening of loops occurs when hanging loops to the outside of the needle bed, it should be noted that this specific type of widening is not claimed. Additionally, applicant's specification sets forth at page 7, line 36-46 that widening occurs via splitting a loop into two loops, which is clearly shown in GB '998. Moreover, GB'998 sets forth that making two loops out of one loop is widening as indicated at page 1, lines 17-27 and page 4, lines 12-92.

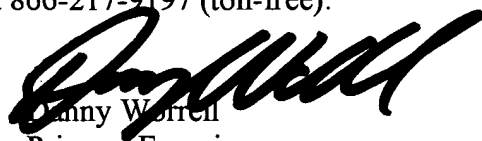
### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danny Worrell whose telephone number is 703/308-0889. The examiner can normally be reached on Tuesday-Friday.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Danny Worrell  
Primary Examiner  
Art Unit 3765

LDW

3/25/05